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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,475	03/29/2001	Paul Douglas Byrd		8612

7590 09/28/2004  
Paul Douglas Byrd  
17 Leisure Valley Drive  
Conway, AR 72032

EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/822,475	<b>Applicant(s)</b> BYRD, PAUL DOUGLAS	
	<b>Examiner</b> Michael J Simitoski	<b>Art Unit</b> 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>8/19/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                 |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The response filed 5/18/04 was received and considered.
2. Claims 1-3 are pending.

### ***General Remarks***

3. A patent describes how to make and use an invention through the description of the invention and through the drawings. Patent claims should exactly describe the invention that receives patent protection. The claims, as they related to this case should describe either a process/method, a machine/apparatus or an improvement on either of them. Some examples of statutory subjects: a computer or machine, a series of operational steps to be performed on a computer. Some examples of non-statutory subjects: compilation of data independent of physical data, digitally recorded music, a process that manipulates abstract ideas or concepts.

The following is a quotation from 35 U.S.C. 271 titled "Infringement of patent" that explains the rights granted by a patent:

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

Patent claims grant the patent holder the right to exclude others from making, selling, offering to sell, import or otherwise using the invention within the scope of the claims. For instance, if a patent were issued, and an independent patentable claim recited: "A vehicle comprising at least 4 wheels", then the patent holder has the right to exclude others from making, using or selling any vehicle with 4 or more wheels, but not a vehicle with 2 wheels, because the claim clearly states that the patent holder's invention is a vehicle with 4 or more wheels.

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Referring to the cited U.S. Patent 5,479,506, claim 2 is a method comprising steps of: obtaining one message ..., analyzing the message ..., determining ..., etc. These steps, performed as set forth in the claim, describe the invention that the patent holder has rights to exclude others from making, using or selling. These steps, whether performed on a desktop computer, supercomputer, laptop computer, etc. are all protected by patent rights because the steps are clearly defined as happening within a "computer". If the claim had read, "The method of preparing a computer file of multi-puzzle cryptographic guessing games from a plurality of html email messages ...", then the patent holder's would only have the right to exclude others from making, using or selling a system that specifically prepares mutli-puzzle cryptographic guessing games using html email messages, not, for instance text email messages, or some other type of computer message.

Referring now to applicant's claims, the claims recite, "I claim all rights ...". The patent office does not have the authority to grant specific "rights". The rights a patent grants are already set forth as the right to exclude others from making, selling or using any invention that falls within the scope of the claims. The claims are also not in the form required by the patent office. For instance, claim 1 could read similarly to the following: "A method of communicating a secret message from a sending device to a receiving device, the method comprising the steps of (a) creating a message containing any combination of characters, numbers and symbols, (b) for each of said character, number, or symbol, creating a corresponding standard symbol, (c) removing one or more graphical components of each symbol to create a modified symbol, so that each modified symbol corresponds to one of the original characters, numbers, or symbols in the message, (d) replacing each of the original characters,

numbers or symbols with its corresponding modified symbol, and (e) sending the message to a recipient using electronic communication means.” The specification would also need to clearly define, through example, etc. all the words in the claim, such as what a “graphical component” (similar to the lines/curves, etc. of the EMBOL symbol), “standard symbol” (the full EMBOL symbol) and “electronic communication means” (such as email) are. *Please note that the above sample claim has not been determined to be patentable, complete or representative of the invention of the instant application. It is to serve only as an example of how an invention similar to the instant one may be described in a claim.*

4. Regarding applicant’s explanations, offered in the response submitted 5/18/04, applicant is reminded that any disclosure relied upon to clarify the claims must be present in the disclosure, as originally filed.

5. Regarding claims 1-3, submitted 5/18/04, no instructions to cancel the original three claims and replace them with new claims has been given. For the purposes of this Office Action, the claims submitted 5/18/04 will be treated as the current claims; regarding form, the submission should be accompanied by either an instruction to cancel the original claims and supply new claims, in which case the new claims should be numbered 4, 5, 6, or an instruction similar to “amend the claims as follows”. The current amendment practice is set forth in 37 CFR 1.121 and a sample is available at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.htm>.

6. Regarding the form of the application, amendments and drawings, should any claims be allowable in further prosecution, the examiner will assist applicant in ensuring the application, submissions, and etc. will be in proper, compliant form.

***Drawings***

7. Regarding the abstract, submitted 5/18/04, no instructions to cancel the original abstract and replace it with the new abstract have been given. For the purposes of this Office Action, the abstract submitted 5/18/04 will be treated as the current abstract, and therefore the objection to the abstract is withdrawn.

8. As the specification/drawings do not appear to have been amended (with the exception of the abstract), the objections to the drawings as set forth in the previous Office Action (4/22/04, page 3) are maintained.

***Specification***

9. As the specification does not appear to have been amended (with the exception of the abstract), the objections to the specification as set forth in the previous Office Action (4/22/04, pages 3-6) are maintained.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are to “rights” rather than a method/process, machine/apparatus, a manufacture (article), composition of matter, or an improvement of any of

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the previous. Applicant is directed to U.S. Patent 5,479,506, particularly to claim 2 as a representative patent claim (method/process).

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the EMBOL language characteristics, does not reasonably provide enablement for “all rights to”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to build or use the invention commensurate in scope with these claims. Specifically, the method disclosed (beginning on page 21 of the specifications) describes encrypting text, but makes no reference to an encryption algorithm. Applicant is reminded that invention must be fully disclosed to obtain a patent. Applicant is further reminded that no new matter should be presented in any amendments to the specification. Further, applicant is reminded that the claims are to clearly describe the scope of the invention, and should make no reference to the “rights” to which applicant seeks.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. As stated above, 35 U.S.C. 101 requires that an invention be a "process, machine, manufacture or composition of matter" and the claims must contain functional components or method steps to properly claim an invention.

16. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The claims are omnibus type claims. Specifically, the following are indefinite:

- a. "DRYBEDOC software": The scope of the claim is indefinite because invention that uses the language is not clearly stated.
- b. "properties or processes of The EMBOL, DRYBEDOC THE EMBOL Language, and DRYBEDOC THE EMBOL Language Private Communication System".

#### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Drybedoc (1988) by Byrd. Inasmuch as the scope of the claims can be determined, the book appears to anticipate



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the invention with the disclosure of "Drybedoc, The EMBOL language" more than one year prior to the date application.

### ***Conclusion***

19. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$165.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

20. In June 2004, the USPTO ceased mailing paper copies of cited U.S. patents and U.S. patent application publications with all Office actions. See "USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies," 1282 O.G. 109 (May 18, 2004). Foreign patent documents and non-patent literature will continue to be provided to the applicant on paper.

All U.S. patents and U.S. patent application publications are available free of charge from the USPTO web site ([www.uspto.gov/patft/index.html](http://www.uspto.gov/patft/index.html)), for a fee from the Office of Public Records (<http://ebiz1.uspto.gov/oems25p/index.html>), and from commercial sources. Copies are also available at the Patent and Trademark Depository Libraries (PTDLs). A list of the PTDLs may be found on the USPTO web site ([www.uspto.gov/web/offices/ac/ido/ptdl/ptdlib\\_1.html](http://www.uspto.gov/web/offices/ac/ido/ptdl/ptdlib_1.html)). Additionally, a new feature in the Office's Private Patent Application Information Retrieval system (PAIR), E-Patent Reference, is available for downloading and printing of U.S. patents and U.S. patent application publications cited in U.S. Office Actions.

## STEPS TO USE THE E-PATENT REFERENCE FEATURE

Access to Private PAIR is required to utilize E-Patent Reference. If you do not already have access to Private PAIR, the Office urges practitioners and applicants not represented by a practitioner to: (1) obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate; (2) obtain a USPTO customer number; (3) associate all of their pending and new application filings with their customer number; (4) install free software (supplied by the Office) required to access Private PAIR and the E-Patent Reference; and (5) make appropriate arrangements for Internet access.

### Instructions for performing the 5 steps:

**Step 1:** Full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page ([www.uspto.gov/ebc/downloads.html](http://www.uspto.gov/ebc/downloads.html)). Note that a notarized signature will be required to obtain a digital certificate.

**Step 2:** To get a Customer Number, download and complete the Customer Number Request form, PTO-SB/125, from the USPTO web site ([www.uspto.gov/web/forms/sb0125.pdf](http://www.uspto.gov/web/forms/sb0125.pdf)). The completed form can be transmitted by facsimile to the Patent Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or agent, your registration number must be associated with your customer number. This association is accomplished by adding your registration number to the Customer Number Request form.

**Step 3:** A description of associating a customer number with the correspondence address of an application is described at the EBC Web page ([www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html)).

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**Step 4:** The software for electronic filing is available for downloading at [www.uspto.gov/ebc](http://www.uspto.gov/ebc). Users can also contact the EFS Help Desk at (703) 305-3028 and request a copy of the software on compact disc. Users will also need Adobe Acrobat Reader, which is available through a link from the USPTO web site.

**Step 5:** Internet access will be required which applicants may obtain through a supplier of their own choice. As images of large documents must be downloaded, high-speed Internet access is recommended.

The E-Patent Reference feature is accessed using a button on the Private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents in Portable Document Format (PDF). The downloaded documents can be viewed and printed using commercially available software, such as ADOBE® READER®. ADOBE® READER® is available free of charge from Adobe Systems Incorporated ([www.adobe.com/products/acrobat/readmain.html](http://www.adobe.com/products/acrobat/readmain.html)).

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191.

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The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**Or faxed to:**

(703)746-7239 (for formal communications intended for entry)

**Or:**

(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

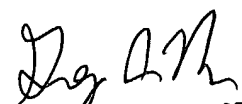
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS  
September 17, 2004



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